

REMARKS

Claims 1-26 are pending in the present application. In the Office Action mailed August 20, 2009, the Examiner rejected claims 1-7, 10-15, 17, 18, and 23-25 under 35 U.S.C. §103(a) as being unpatentable over Neville et al. (USP 6,272,636) in view of Manduley (USP 5,956,505). The Examiner next rejected claims 8, 9, and 16 under 35 U.S.C. §103(a) as being unpatentable over Neville et al. in view of Manduley, and further in view of Linden et al. (USP 6,360,254). Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Neville et al. in view of Manduley, and further in view of Earnest (USP 4,888,798). Claims 20-22 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Neville et al. in view of Manduley, and further in view of Oki et al. (USP 6,115,471).

Claim Amendments

Applicant has amended claims 1 and 23 to further define the scope of the invention. As amended, each of claims 1 and 23 calls for, in part, a method to remotely enable software-enabled options on equipment/device that includes the steps of receiving a user I.D. at a centralized facility, receiving an option-enabling request specifying an option requested to be enabled in the equipment/device at a subscribing station, confirming that the option has not already been enabled, and generating an enabling feature at the centralized facility upon confirmation that the option has not already been enabled, the enabling feature comprising a software key designed to enable software already installed in the device.

Additionally, claims 2, 3, and 24 have been canceled.

Rejection of claims 1, 10, 18, and 23 under 35 U.S.C. §103(a) as being unpatentable over Neville et al. in view of Manduley

The Examiner rejected claims 1, 10, 18, and 23 under 35 U.S.C. §103(a) as being unpatentable over Neville et al. in view of Manduley. In rejecting the claim, the Examiner recognized that “the Board of Patent Appeals and Interferences Decision (Appeal Number 2006-0490...), decided 9 May 2006, [held] that Neville does not explicitly disclose... receiving an option enabling request.” *Office Action*, August 20, 2009, p. 4. The Examiner thus asserted that “Manduley teaches receiving an option-enabling request (Abstract – ‘a method is provided for activating an optional feature... method also includes receiving a request to operate one of the optional features’).” *Id.* The Examiner further asserted that “Neville in view of Manduley discloses... creating an option key.” *Id.* at 6. Applicant respectfully disagrees with the rejection.

Specifically, Applicant believes there would be no motivation to combine the cited references in the manner done so by the Examiner to achieve the present invention and that, in fact, the teachings of Neville et al. are contrary to the teachings of Manduley.

Each of claims 1, 10, 18, and 23 call for, in part, a system/method for remotely enabling software-enabled options on equipment/device that includes receiving a user I.D. at a centralized facility, receiving an option-enabling request specifying an option requested to be enabled in the equipment/device at a subscribing station, confirming/validating that the option has not already been enabled, and generating a software/option key at the centralized facility upon confirmation that the option has not already been enabled, with the software/option key being transmitted from the centralized facility to the equipment/device to activate the option.

Neville et al. teaches a system whereby an end user can execute an evaluation copy of a specific digital product and, if so desired, follow a sequence of steps to purchase the non-evaluation version of the digital product. Neville et al. thus sets forth a system that employs “metering,” whereby upon an attempt to execute an evaluation version of a digital product, the evaluation version communicates with a server/clearinghouse to determine whether the evaluation version can be used by that particular end user at the particular time of the request. *See Neville et al.*, Col. 13, Ins. 20-31. If the server/clearinghouse determines that the user is within the evaluation period, the server/clearinghouse then transmits an unlock key to the evaluation version of the digital product, thereby allowing the digital product to execute for that particular instance. *Id.* However, if the server/clearing house determines that the end user is outside of the evaluation period, the user is informed that the digital product cannot be executed. *Id.* at Ins. 31-35. This “approval process,” including downloading the unlock key, must be repeated each and every time the user wishes to execute the evaluation version of the digital product. Simply, Neville et al. teaches a system of “execution control.” This means that just prior to every execution of a digital product, approval from a server/clearinghouse must be secured before the application is allowed to start. *See Title of Neville et al.* and Col. 13, Ins. 20-35.

With specific reference to transmission of the unlock key upon determining by the server/clearinghouse that the user is within the evaluation period, Neville et al. further discloses that “[t]he server stores a symmetric unlock key used previously by the builder (FIG. 7) to encrypt selected portions of the metered application, e.g., code section 302 (FIG. 4) and entries 408 in section table 300d’.” *Neville et al.*, Col. 10, Ins. 46-50. Thus, the server of Neville et al. does not create an option key in response to an option request. Rather, Neville et al. is clear that any “unlock key” is created well before any request because Neville et al.’s unlock key is

necessary to build the very execution controlled product that ultimately makes a request. *Id.* Accordingly, Neville et al. teaches away from the server creating an unlock key because the server must instead retrieve and send a “stored” unlock key. *Id.*

In opposition to Neville et al., Manduley sets forth a device 20 that includes an application manager 42 and a program activation module 58 therein that control access to, and activation of, application programs and their various features stored on an “activation map” of the program activation module 58. *Manduley*, Col. 5, lns. 3-6. The device 20 (and the application manager 42 and program activation module 58 thereon) communicates with a remote data center to request codes therefrom and receive activation codes upon confirmation of a verified user/device making the request. *Manduley*, Col. 7, lns. 40-45. A process by which the data center processes a request from device 20 begins with receipt of the request at the data center. The data center decrypts the received request code in order to determine what programs or features are requested to be activated. *Manduley*, Col. 7, lns. 61-63. Upon decryption, the data center updates the customer's file to reflect activation of the requested programs or features and generates a code that, when entered into device 20, will cause device 20 to update its activation map to activate the requested application or features. After the activation code is generated, it is encrypted. *Manduley*, Col. 8, lns. 17-37. The code is then transmitted via a data communication link back to device 20, where it is entered either manually or automatically to update the activation map of program activation module 58, thereby activating the requested application program(s). *Id.*

With respect to generation of the activation code, Manduley thus teaches that the data center (i.e., a server at the data center) is configured to generate and encrypt the activation code upon receipt of a request code from either device 20 or from a user. That is, the data center first receives and decrypts the request code in order to determine what programs or features are requested to be activated and then, responsive thereto, generates a code that will cause device 20 to update its activation map to activate the requested application or features. *Manduley*, Col. 7, lns. 61-63 and Col. 8, lns. 17-37. The data center thus does not generate the activation code until after receipt of a request code from device 20.

In light of the teachings of Neville et al. and Manduley, Applicant believes that there is no suggestion or motivation that would lead one of skill in the art to combine the references. Specifically, Applicant believes that the teachings of Neville et al. are contrary to the teachings of Manduley, and as such, there would be no motivation to combine the references to achieve the present invention. MPEP §2143(V) states that “[i]f proposed modification would render the prior

art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Similarly, MPEP §2145.X.D.2 states that “[i]t is improper to combine references where the references teach away from their combination.” Applicant believes that the teaching of Manduley, that an activation code is not generated until after receipt of a request code from device, cannot be combined with the teaching of Neville et al., that an unlock key is created well before any request is made.

As stated above, the combination of the system of Manduley and the system of Neville et al. would render Neville et al. unfit for its intended purpose. One of ordinary skill in the art would readily recognize that there is a distinct difference between retrieving a previously stored key in response to a request and generating anew, a key in response to a request. Simply, Neville et al. teaches that all keys are created when building an execution controlled product. Therefore, Neville et al. teaches that the keys are stored by the server and later retrieved and supplied upon request and are not created. *Neville et al.*, Col. 10, lns. 46-50. Conversely, and in direct opposition to Neville et al., Manduley teaches that an activation code is not generated until after receipt of a request code from device. Manduley, Col. 8, lns. 17-37. Furthermore, since Neville et al. teaches that it is *necessary* for the keys to be created in order to build an execution controlled product and the ultimate goal of Neville et al. is to create an execution controlled product, *Neville et al.*, Col. 10, lns 46-50, modifying Neville et al. to create keys later in response to either a request or validation of a request or user ID would preclude Neville et al. from ever building the execution controlled product. Simply, since the keys are required to be created prior to creating the end product, they cannot be created later in response to either a request or validation of a request or user ID, as taught in Manduley. Therefore, the combination of Neville et al. and Manduley would render Neville et al. inoperable for its intended purpose and the combination in this manner is precluded under MPEP §§2143(V) and 2145.X.D.2.

While Applicant is mindful of the decision in *KSR Int’l Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007), and its teachings regarding findings of obviousness, Applicant believes that the Examiner has still not met the burden for showing a teaching, suggestion, or motivation to combine the cited references. That is, while the holding in *KSR* supports an expansive and flexible approach for showing the requisite teaching, suggestion, or motivation in determining obviousness, the Examiner’s analysis supporting a rejection under 35 U.S.C. 103 should be made explicit, and rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See KSR*, supra at 1396; *see also Federal Register*, Vol. 72, No.

195, October 10, 2007, p. 57528-57529. In the present case, the Examiner has failed to provide such a “rational underpinning” to support the legal conclusion of obviousness. That is, the Examiner has not shown how it would be possible to modify Neville et al. to perform the disclosed functions using keys created by the server as taught in Manduley. Applicant believes that the contradictory teachings of the references themselves refute any reason(s) asserted by the Examiner as to why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed, at least because the combination of Neville et al. and Manduley would render Neville et al. inoperable for its intended purpose.

In light of the above, Applicant believes that there would be no motivation to combine the cited references in the manner done so by the Examiner to achieve the present invention. Each of claims 1, 10, 18, and 23, along with the claims dependent therefrom, is thus believed to be patentably distinct from Neville et al. and Manduley.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1, 4-23, and 25-26.

Applicant appreciates the Examiner’s consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

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General Authorization and Extension of Time

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2402. Should no proper payment be enclosed herewith, as by credit card authorization being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-2402. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extensions under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-2402. Please consider this a general authorization to charge any fee that is due in this case, if not otherwise timely paid, to Deposit Account No. 50-2402.

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